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Docket No. YOR920000202US1  
(YOR.094)

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**REMARKS**

Claims 1, 4-7, 9-19, and 21-25, and 33-35 are all the claims presently pending in the application.

Claims 26-32, 36, and 37 stand withdrawn from consideration as being directed to non-elected species of the invention having no linking claim. Claims 26-32, 36, and 37 are canceled without prejudice or disclaimer to the filing of a divisional application directed to these claims.

Applicants gratefully acknowledge that claims 1, 4, 6, 7, 9-17, 33, and 34 are allowed and claim 5 would be allowable if amended to obviate the Examiner's objection.

To expedite prosecution, allowable claim 5 is amended in accordance with the Examiner's suggestion, thereby placing allowable claim 5 in condition for immediate allowance.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph.

Claims 18, 19, 21-25, and 35 stand rejected under U.S.C. § 102(e) as being anticipated by Fong (U.S. Patent No. 6,279,015).

These rejections are respectfully traversed in the following discussion.

**I. THE CLAIMED INVENTION**

The claimed invention is directed to a method of reconciling component variables with container variables in a document.

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In conventional document assembly systems, importation of document components is typically based on fixed criteria which presents problems for complex documents. For example, a particular clause may be reused throughout a document, and it may be integrated within a larger assembly of document components which is referred to as a "container" or "container assembly". There must be links between the container assembly and the document component being imported during document assembly, and both items may contain variables which may refer to the same domain concepts (e.g., see specification at page 3, line 20 to page 4, line 5).

However, maintaining consistency between these variables once the document component (source component) has been imported presents problems unless these variables representing the same concepts are somehow linked to one another. Hitherto the present invention, such a solution has not been provided and hence these problems have been prevalent (e.g., see specification at page 4, lines 6-10).

Instead, with the conventional systems and methods, there are simply container variables and components (e.g., see specification at page 5, lines 9-10).

In conventional systems, the component (independent of its content) that structures the variables together is not independent of the value assignment. As a result, no manual linking of these concepts is provided, and thus there is minimal (if any) flexibility and/or reusability of the components since the components are not generally applicable or generic (e.g., see specification at page 6, lines 1-5).

Further, there may be several different components in the document that all refer to the same concepts (e.g., the company's address is repeated in different places throughout the document). However, since in conventional systems the variables in the different components are not linked, if the company's address is changed in one location, it will not be updated

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elsewhere. This is a serious maintenance problem that would be fatal to a system that relies heavily on component-based drafting (e.g., see specification at page 6, lines 6-12).

In the claimed invention, on the other hand, there are three concepts which are considered, including the position in the document where the component goes, the component itself that plugs in and out of the position in the document, and the particular domain model information which plugs into the component. The novel and unobvious reconciler of the claimed invention allows a manual linking of these concepts, thereby allowing greater flexibility and greater reusability of the components because the components are more generally applicable (e.g., see specification at page 9, lines 11-18).

Thus, with the unique and unobvious features of the claimed invention, the user can reduce its database requirements, increase flexibility and reusability in that, for any given document component, the document component can be applied more generically to increase its reusability (e.g., more generically reusable). The user also can determine the linkages and leverage loose coupling of the domain knowledge and document knowledge. Further, the invention allows reconciliation to be performed interactively by the user (e.g., see specification at page 9, line 19, to page 10, line 3).

## II. THE 35 U.S.C. §112 REJECTION

Claim 22 stands rejected under 35 U.S.C. § 112, second paragraph.

As with the objection to the specification below, the Examiner alleges that the amendment to claim 22 adds new matter.

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As the Examiner surely is aware, an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.

Applicants note that original claim 19 recites, *inter alia*, “a reconciler for mapping variables in said container, with variables in said component” (emphasis added).

On the other hand, original claim 22 depends from claim 19 and recites, *inter alia*, “*if the variable in the component has a value, then no swapping is performed by said reconciler*” (emphasis added).

Clearly, the term “swapping” is an obvious error. That is, the reconciler clearly performs “mapping”, not swapping. Indeed, the specification repeatedly describes the “mapping” being performed by the reconciler.

The ordinarily skilled artisan clearly would recognize the existence of such an error in claim 22, as well as recognize the appropriate correction.

As the Examiner surely knows, the language of original claim 22 clearly is part of the original disclosure.

The amendment to claim 22 clearly was directed to correcting an obvious error. Indeed, Applicants submit that the amendment to claim 22 clearly would be understood by the ordinarily skilled artisan as correcting such an obvious error. Again, it is noted that an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.

Clearly, this is the case in the present application. Indeed, the sole occurrence of the term “swapping” in the original disclosure appears in original claim 22.

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Applicants submit that the ordinarily skilled artisan would know and understand that claim 22 is directed to "mapping", not swapping, in view of the specification, drawings, original claims, and the state of the art.

For the foregoing reasons, the amendment to claim 22 clearly does not constitute new matter.

If the Examiner maintains this rejection, then the Examiner should properly explain why such would not have been understandable to the ordinarily skilled artisan, as well as why the Examiner doubts the truth or veracity of Applicants' assertions that the ordinarily skilled artisan would not understand that original claim 22 included such an obvious error.

Therefore, the Examiner respectfully is requested to withdraw this rejection of claim 22.

### III. THE PRIOR ART REJECTION

Claims 18, 19, 21-25, and 35 stand rejected under U.S.C. § 102(e) as being anticipated by Fong (U.S. Patent No. 6,279,015). Applicants respectfully traverse this rejection, for at least the following reasons.

In the Response to Arguments, the Examiner acknowledges that the Office Action merely has cited all of the Figures (i.e., 1-20) and all of the disclosure (i.e., column 1, line 1 through column 44, line 19) of the Fong reference in support of the rejection of the above claims.

However, the Examiner asserts that the Examiner also has explained why the subject matter in Fong discloses each limitation. The Examiner further alleges that the subject matter discussed in the Examiner's explanation is found within the cited portion of Fong (i.e., the entire Fong reference). Thus, the Examiner alleges that Applicant could have properly responded to the Examiner's position.

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Applicants respectfully disagree.

Since the Examiner has not cited with any particularity the support in the Fong reference upon which the Examiner relies, Applicant cannot properly rebut the Examiner's position.

Indeed, the Examiner's assertion that merely citing the entire reference in support of the rejection somehow conveys the Examiner's position clearly is contrary to the Interim Examination Guidelines published by the U.S. Patent Office in November 2005.

Moreover, the Examiner's explanation of why the subject matter in Fong discloses each limitation includes a general conclusion that Fong allegedly discloses each element of the claims with reference to SGML and HTML elements (see Office Action at pages 6-11).

However, Applicants respectfully reiterate that the Examiner has not identified any support for these allegedly disclosed features other than to say that they are included in the entire disclosure of Fong.

As the Examiner knows, each and every element must be present in Fong, in as complete detail as recited in the claims, in order to anticipate the claimed invention.

Applicant submits that it is unclear which elements of Fong the Examiner is relying on to support each and every element of the claims, particularly in view of the lengthy specification (44 columns) and numerous drawings (Figures 1A-20H) of Fong.

Thus, a *prima facie* case of anticipation clearly has not been established at least with respect to the rejected. Applicants reiterate that Applicants' cannot properly respond to the Examiner's position, since it is unclear what portions of Fong the Examiner believes anticipate each and every element of the claimed invention.

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Thus, should the Examiner maintain this rejection, Applicants respectfully reiterate the request that the Examiner properly identify which portions of Fong allegedly disclose or suggest each and every element of the claimed invention, as recited in claims 18, 19, 21-25, and 35.

In view of the foregoing, Applicants respectfully submit that the Examiner has not established a *prima facie* case of anticipation with respect to claims 18, 19, 21-25, and 35.

Applicants reserve the right to traverse this rejection at such time that the Examiner properly identifies the features of the Fong reference which are deemed to anticipate the claimed invention (i.e., at such time that a *prima facie* case of anticipation properly is established).

The Examiner respectfully is requested to reconsider and withdraw the rejection of these claims, or alternatively, properly establish a *prima facie* case of anticipation of claims 18, 19, 21-25, and 35.

#### IV. FORMALITIES

##### A. Objections to the claims

The Office Action objects to allowable claim 5. To expedite prosecution, allowable claim 5 is amended herewith in accordance with the Examiner's suggestions, thereby obviating this objection.

Accordingly, the Examiner is requested to reconsider and withdraw the objection to allowable claim 5. Claim 5 should now be allowed.

##### B. Objections to Specification

At pages 2-3 of the Office Action, the Examiner objects to the sentence "[i]n yet another exemplary aspect of the invention, if the variable in the component has a value, then no mapping

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is performed by the reconciler". The Examiner states that the added material is not supported by the original disclosure, and therefore, introduces new matter into the disclosure.

As the Examiner surely is aware, an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.

Applicants note that original claim 19 recites, *inter alia*, "a reconciler for mapping variables in said container, with variables in said component" (emphasis added).

On the other hand, original claim 22 depends from claim 19 and recites, *inter alia*, "if the variable in the component has a value, then no swapping is performed by said reconciler" (emphasis added).

Clearly, the term "swapping" is an obvious error. That is, the reconciler clearly performs "mapping", not swapping. Indeed, the specification repeatedly describes the "mapping" being performed by the reconciler.

The ordinarily skilled artisan clearly would recognize the existence of such an error in the specification, as well as recognize the appropriate correction.

Turning to the specification, the language of original claim 22, which clearly is part of the original disclosure, was added to the specification in the Amendment under 37 C.F.R. § 1.111 filed on July 7, 2005, in response to the Examiner's objection to the specification in the Office Action mailed on April 7, 2005. That is, in the previous Amendment, Applicants incorporated the features recited in the original claims (i.e., which are part of the original disclosure) into the "Summary of the Invention" section of the specification to obviate the Examiner's objection.

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The amendments to the specification and claim 22 clearly are directed to correcting this obvious error. Indeed, Applicants submit that the amendments to the specification and claim 22 clearly would be understood by the ordinarily skilled artisan as correcting an obvious error. Again, it is noted that an amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.

Clearly, this is the case in the present application. Indeed, the sole occurrence of the term "swapping" appears in original claim 22.

Applicants submit that the ordinarily skilled artisan would know and understand the claimed invention in the context of the specification, drawings, original claims, and the state of the art.

Thus, the Examiner is requested to reconsider and withdraw this objection.

At page 3, first full paragraph, of the Office Action, the Examiner objects to the sentence "[t]he reconciliation algorithm has mapped document variable A to container variable 1 (e.g., mapped document variable A from the document component's (e.g., reference numeral 12) to container variable 1 in the container assembly 11)" (see specification at page 13, lines 12-14), because the text inside the parentheses of this sentence allegedly does not correspond to the preceding portion of the sentence and allegedly is difficult, if not impossible, to understand.

Applicants respectfully submit, however, that nothing in the parentheses fails to correspond with the preceding portion of the sentence. Indeed, the portion in parentheses merely provides a more detailed example. Thus, it is not clear *why* the Examiner has deemed these sentences to be unclear, or why the Examiner proposes deleting portions of these sentences.

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Applicants submit that the subject sentences would be understandable to the ordinarily skilled artisan, as written.

However, to expedite prosecution, Applicants amend this sentence to provide clarification and to obviate the objection. Thus, the Examiner is requested to reconsider and withdraw this objection.

At page 3, second full paragraph, of the Office Action, the Examiner objects to the sentence “[a]dditionally, the reconciliation algorithm has mapped component variable B to container variable 3 ( (of the document component 12) in the container assembly 11 (e.g., containing document) )”, because the text inside the parentheses of this sentence allegedly does not correspond to the preceding portion of the sentence and allegedly is difficult, if not impossible, to understand.

Applicants respectfully submit, however, that nothing in the parentheses fails to correspond with the preceding portion of the sentence. Indeed, the portions in parentheses merely provide examples. Thus, it is not clear *why* the Examiner has deemed these sentences to be unclear, or *why* the Examiner proposes deleting portions of these sentences. Applicants submit that the subject sentences would be understandable to the ordinarily skilled artisan, as written.

However, to expedite prosecution, Applicants amend this sentence to provide clarification and to obviate the objection. Thus, the Examiner is requested to reconsider and withdraw this objection.

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**VI. CONCLUSION**

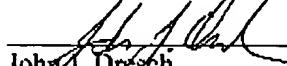
In view of the foregoing, Applicant submits that claims 1, 4-7, 9-19, and 21-25, and 33-35, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,

Date: MAY 30, 2006

  
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**CERTIFICATE OF TRANSMISSION**

I certify that I transmitted via facsimile to (571) 273-8300 the enclosed Amendment under 37 C.F.R. § 1.116 to Examiner William D. Hutton, Jr., Art Unit 2176, on May 30, 2006.

  
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